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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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HM12/1023

EXAMINER

JIANG, S

ART UNIT	PAPER NUMBER
1617	

1617

DATE MAILED: 10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

DETAILED ACTION

This application is a 371 of PCT/EP99/09053 which claims priority to EPO 98203914.1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 provides for the use of a compound of formula I in claim 13, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

In order to expedite prosecution, these claims will be examined on the merits as a method of use herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lobaccaro et al. (AQ, PTO-1449 submitted June 25, 2001).

Lobaccaro et al. teach compound 5b therein, within the instant claimed compounds, and its composition. See Scheme 1 compound 5b on page 2218, Table 1 on page 2219, Table 2 on page 2221, and the 4th paragraph of page 2224. Lobaccaro's teaching is also inherent in a method of the treatment of estrogen-deficiency dependent disorders. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Lobaccaro et al. anticipates the claimed invention.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Napolitano et al. (AR, PTO-1449 submitted June 25, 2001).

Napolitano et al. teach 11 β -substituted estradiol derivatives as the estrogen receptor such as compound 21 therein within the instant claimed compounds and its composition. See abstract and Table 1 on page 2776. Napolitano's teaching is also inherent in a method of the treatment of estrogen-deficiency dependent disorders. See *Ex parte Novitski*, 26 USPQ 2d 1389. Thus, Napolitano et al. anticipates the claimed invention.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Baran et al. (3,755,301, PTO-892).

Baran et al. disclose 11-alkyl steroids within the instant claimed compounds. See abstract and col.1 lines 2-21. Thus, Baran et al. anticipates the claimed invention.

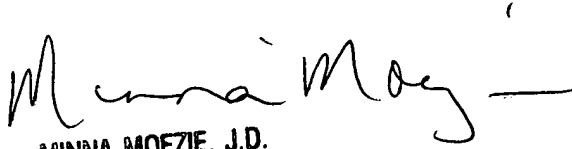
In view of the rejection to the pending claim set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

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October 12, 2001


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